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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,064	10/16/2003	Francois Gauthier	A01457	8923

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EXAMINER

ALSTRUM ACEVEDO, JAMES HENRY

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,064

Applicant(s)

GAUTHIER ET AL.

Examiner

James H. Alstrum-Acevedo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 3-4, 6, and 8-9 are pending. Receipt of Applicant's amendments and arguments filed on January 26, 2006 is acknowledged. Said arguments and amendments were fully considered.

Specification

The objection of claim 4 is withdrawn, due to Applicant's amendment to said claim.

The use of trademarks has not been properly corrected. The use of the trademarks TEXANOL[®] (page 7, line 26) and PERAMIN SRA[®] (page 7, line 32) has been noted in this application, and was noted on page 1 of the previous office action. Trademarks *should be capitalized* wherever they appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

The rejection of claims 5 and 10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention *is moot*, because said claims have been cancelled.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of claims 1-10 under 35 U.S.C. 102(b) as being anticipated by Lehmann et al. (U.S. Patent No. 4,644,031, reissued as Re. 35,200) **is maintained** with regards to non-cancelled claims (i.e. claims 1, 3-4, 6, and 8-9).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of claims 1-10 under 35 U.S.C. 103(a) as being unpatentable over Lehmann et al. (U.S. Patent No. 4,644,031, reissued as Re. 35,200) **is maintained** with regards to the non-cancelled claims (i.e. claims 1, 3-4, 6, and 8-9).

The rejection of claims 1-10 under 35 U.S.C. 103(a) as being unpatentable over Zagnoli (U.S. Patent No. 3,030,273) in view of Duccini et al. (EP 0812905 A2) **is maintained** with regards to the non-cancelled claims (i.e. claims 1, 3-4, 6, and 8-9).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 1010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The rejection of claims 1-3 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 5,922,661 in view of Campbell, Ian (*Introduction to Synthetic Polymers*, Oxford University Press: New York, 1994, pp 148-150) **is maintained**.

The rejection of claims 1-3 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No. 5,883,061 in view of Campbell, Ian (*Introduction to Synthetic Polymers*, Oxford University Press: New York, 1994, pp 148-150) **is maintained**.

Response to Arguments

Applicant's arguments filed January 26, 2006 have been fully considered but they are not persuasive. The basis of Applicant's traversal of the rejection of the current pending claims under 35 U.S. C. 102(b) over Lehmann et al. (Re. 35,200) is that the Examiner improperly used the inherency argument. The Applicant asserted that the degree of neutralization of the carboxylic acid functional groups of a polyelectrolyte, such as poly(acrylic acid), is critical to their invention and would not behave in a conventional manner compared to organic carboxylic

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acids. The Examiner respectfully points out that poly(acrylic acid) is comprised of organic carboxylic acids. Furthermore, in Lehmann's Example 1, cited on page 9 of the previous office action, it is noted that the pH of the dispersion used to make the coated tablet is 5.7. Utilizing this pH value, the known pKa value for acrylic acid (4.26), and the Henderson-Hasselbalch equation to estimate the degree of neutralization of the carboxylic acid moieties of acrylic acid, a person of ordinary skill would calculate that approximately 96% of the carboxylic acid moieties are neutralized. Therefore, Lehmann does inherently meet this limitation recited in claims 1 and 6 of the instant application. Even if one could argue that Lehmann's disclosed method and composition did not inherently meet the degree of neutralization recited in the instant application, it would have been obvious to a person of ordinary skill in the art at the time of the instant application that the weakly acidic carboxylic acid functional groups contained within the structural frame work of poly(acrylic acid) would have had a degree of neutralization greater than 30%, because the known pKa of acrylic acid is 4.26. As is well known in the art, whenever the pH equals the pKa of a given weak acid, 50% of the acid functional groups in solution would be neutralized. This is self-evident from the Henderson-Hasselbalch equation (Brown, T. L. et al. *Chemistry: The Central Science*, 6th edition, Prentice Hall: Englewood Cliffs, NJ, 1994, pp. 630.). For the pKa of acrylic acid, the Applicant is pointed to Schüürmann et al.'s Table 1 on page 6708 (*J. Phys. Chem. A*. **1998**, *102*(33), 6706-6712).

The Applicant also traversed the rejection of claims 1-10 under 35 U.S.C. §103(a) over Zagnoli (U.S. Patent No. 3,030,273) in view of Duccini et al. (EP 0812905 A2), because methylmethacrylate is not water-soluble. The Examiner agrees that methylmethacrylate is not water-soluble, however, it is noted that the teachings of Zagnoli and Duccini are not limited to

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homopolymers of methymethacrylate, but rather include copolymers wherein methymethacrylate is a comonomer. Therefore, Applicant's arguments in view of the combined teachings of both Zagnoli and Duccini are not persuasive. It is also emphasized that Duccini teaches it is important that the carboxylic acid containing polymers be neutralized so that they are soluble (page 2, line 55 of Duccini and page 10 of the previous office action).

Conclusion

Claims 1, 3-5, 6, and 8-9 (all pending claims) are rejected. No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

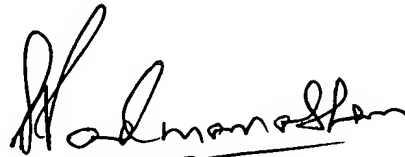
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Alstrum-Acevedo whose telephone number is (571) 272-5548. The examiner can normally be reached on M-F, 9:00-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Alstrum-Acevedo, Ph.D.
Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER